

REMARKS

Claims 1-35 are all the claims presently pending in the application.

Claims 4 and 9 have been amended merely to make a minor editorial changes and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-35 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement.

This rejection is respectfully traversed in the following discussion.

I. CLAIM REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 1-35 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement.

The Examiner asserts that “continuously transmitting to the wireless device for allowing a user to locate an alternate communication mechanism after the failure has occurred” fails to comply with the enablement requirement because “*if the wireless device has a failure (i.e. the wireless device is broken or a receiver is broken), how would it receive an alternate communication mechanism from a base station or service provider*” (see Office Action at page 2, lines 12-16).

Applicants submit that the ordinarily skilled artisan could certainly, without undue experimentation, make and use the claimed invention of a system and method for locating an alternate communication mechanism in case of failure of a wireless communication device after a thorough reading of the specification with reference to the drawings. Therefore, Applicant respectfully traverses this rejection for the following reasons.

In the claimed invention, the information with respect to an alternate communication mechanism is pushed (i.e., transmitted) to the device continuously, prior to the failure of the device. Thus, when the device fails, the information is already present in the device memory and readily available to the user (e.g., see specification at page 5, lines 9-12, page 6, lines 3-7, and page 13, lines 11-16).

Moreover, the failures considered in the invention include those that render the device unusable for its intended purpose (e.g., making voice calls), not “broken” as alleged by the Examiner.

Common reasons for rendering the device unusable for its intended purpose may include, for example, loss of connection to the wireless network and loss of battery power (e.g., see specification at page 2, lines 9-14).

Further, the disclosure clearly states that wireless operation requires substantially more battery power than displaying information on an LCD screen. Thus, even after the device has become unusable for its intended purpose because of insufficient battery power, the device is still

able to display on its LCD screen information about an alternate communication mechanism
(e.g., see specification at page 5, lines 13-19).

For at least the foregoing reasons, Applicant has complied with all of the requirements for establishing the enablement of the claimed invention, and moreover, has specifically identified and explained for the Examiner the corresponding description in the original specification of the disputed claimed structures, thereby clearly rebutting each of the Examiner's comments.

Applicant notes that, as ample case law has held, the test for enablement is whether one of ordinary skill in the art could practice (e.g., make and use) the invention (e.g., the claimed invention), without undue experimentation.

In light of the specific examples in the original disclosure, Applicant submits that the ordinarily skilled artisan could certainly make and use the claimed invention of a system and method for locating an alternate communication mechanism in case of failure of a wireless communication device after a thorough reading of the specification with reference to the drawings. In other words, one of ordinary skill in the art could practice (e.g., make and use) the invention, without undue experimentation.

Thus, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-35 under 35 U.S.C. § 112, first paragraph, and accordingly, that the Examiner permit claims 1-35 (all of the claims of the present application) to pass to immediate allowance.

II. FORMAL MATTERS AND CONCLUSION

The Office Action objects to the disclosure because of informalities. Particularly, the Office Action asserts that, at page 3, line 8 and page 3, line 9, the parenthesis should be removed.

However, Applicant respectfully submits that the Examiner has not established a reason why such parenthesis should be removed. Applicant respectfully submits that the disclosure is grammatically correct as written, and therefore, no amendments to the disclosure have been made at this time. The Examiner is respectfully requested to withdraw this objection.

In view of the foregoing, Applicant submits that claims 1-35, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

U.S. Application Serial No. 09/788,502
Docket No. ARC9-2000-0074-US1
ALM.049


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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 09-0441.

Respectfully Submitted,

Date:

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